

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 09/386,556
Filing Date: August 31, 1999
Title: PERIPHERAL UNIVERSAL BUS HUB

Page 2
Dkt: 450.262US1

11. (Amended) The wireless peripheral hub of claim 9, wherein the peripheral hub is selected from a group of peripheral hub types consisting of:
USB, [parallel] parallel port, serial port, IEEE-48, RS-232, Centronics [parallel] parallel, and gameport I/F.

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on January 30, 2002, and the references cited therewith.

Claims 1, 8 and 11 are amended, claims 3, 6, and 23-25 are canceled, and no claims are added; as a result, claims 1-2, 4-5, 7-22, and 26-28 are now pending in this application.

Applicant has canceled claims 3, 6 and 23-25 to expedite prosecution and reserves the right to reintroduce the claims in a continuing application. Claim 1 has been amended to more particularly describe what Applicant considers the invention. Claims 8 and 11 have been amended to correct minor spelling errors. Applicant believes that no new matter has been introduced with the amendments.

§102 Rejection of the Claims

Claims 1-2, 4 and 8 were rejected under 35 USC § 102(b) as being anticipated by Nanba (US 6,297,870). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that a *prima facie* case of anticipation is not present, because Nanba does not disclose each and every element as arranged in the claims.

An example of an element not disclosed in Nanba is found in amended independent claim 1, which recites in part “a wireless interface coupled to the input device and operable to

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 09/386,556
Filing Date: August 31, 1999
Title: PERIPHERAL UNIVERSAL BUS HUB

Page 3
Dkt: 450.262US1

communicate with a host computer." Applicant has reviewed Nanba, including performing a computerized text search, and can find no reference to a wireless communications interface. Additionally, the Office Action states in paragraph 8 that Nanba does not explicitly teach a wireless connection. Thus Nanba does not teach each and every element of Applicant's amended claim 1. Applicant respectfully requests the withdrawal of the rejection of claim 1.

Claims 2, 4 and 8 depend from claim 1. These dependent claims inherit the elements of claim 1, including the wireless interface noted above, and add further patentable distinctions. Claims 2, 4 and 8 are therefore not anticipated for the same reasons as discussed above with respect to claim 1. Applicant respectfully requests the withdrawal of the rejection of claims 2, 4 and 8.

§103 Rejection of the Claims

Claims 3, 5-7 and 9-28 were rejected under 35 USC § 103(a) as being unpatentable over Nanba (US 6,297,870) in view of Garney et al. (US 5,890,015). In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully submits that a *prima facie* case of obviousness does not exist with respect to the pending claims because the combination of Nanba and Garney does not teach each and every element of Applicant's claims, and because no proper motivation to combine the references has been provided.

Claims 5 and 7 depend from claim 1, and therefore inherit the recitation of "a wireless interface coupled to the input device and operable to communicate with a host computer." Independent claims 9, 12, 17-19, and 26 each recite similar language with respect to a wireless connection with a host computer. As correctly noted in the Office Action, Nanba does not

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 09/386,556
Filing Date: August 31, 1999
Title: PERIPHERAL UNIVERSAL BUS HUB

Page 4
Dkt: 450.262US1

disclose a wireless connection with a host computer. However, the Office Action goes on to state that Garney teaches a wireless Universal Serial Bus (USB) System. Applicant respectfully submits that Gamey does not teach a wireless connection to a host computer. In fact, Garney teaches a wireless connection with a USB hub. Figures 4-6 of Garney and the accompanying text in column 5, line 30 to column 6, line make it clear that the wireless connection is to a external USB hub 250 through a wireless system side module 421. The wireless connection is not to computer 200. Thus Garney does not teach a direct wireless connection to a host computer. Therefore neither Nanba nor Garney, alone or in combination, teach each and every element of Applicant's claims. As a result, a *prima facie* case of obviousness does not exist with respect to claims 5, 7, 9, 12, 17-19, and 26. The Examiner is respectfully requested to withdraw the rejection of these claims.

Claims 10 and 11 depend from claim 9, claims 13-16 depend from claim 12, claims 20-22 depend from claim 19, and claims 27-28 depend from claim 26. These dependent claims inherit the elements of their respective base claims and add further patentable distinctions. Applicant respectfully submits that these claims are not obvious for at least the same reasons as discussed above. Applicant respectfully requests the withdrawal of the rejection of claims 10-11, 13-16, 20-22 and 27-28.

Additionally, no proper motivation to combine Nanba with Garney has been provided. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). The Office Action stated "It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Nanba and Garney, because this would improve the mobility" which is a mere conclusory statement of subjective belief. Therefore Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references.

Furthermore, the teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. Also the Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). The fact that references can be combined or

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 09/386,556
Filing Date: August 31, 1999
Title: PERIPHERAL UNIVERSAL BUS HUB

Page 5
Dkt: 450.262US1

modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01. Applicant notes that neither reference discusses mobility as a desirable attribute. As a result, Applicant respectfully submits that the Office Action has used hindsight reasoning using the teachings of Applicant's disclosure.

For the above reasons, no motivation to combine Nanba with Garney is present, and therefore a *prima facie* case of obviousness does not exist. Applicant respectfully requests the withdrawal of the rejection of claims 5, 7 and 9-22 and 26-28

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,
BRUCE A. YOUNG ET AL.

By their Representatives,
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6954

Date July 30, 2002 By R.L.L.
Rodney L. Lacy
Reg. No. 41,136

The undersigned hereby certifies that this correspondence is being transmitted by fax (FAX NO. 703-746-7239) to: Commissioner for Patents, Washington, D.C. 20231, on this 30th day of July, 2002.

Candis B. Buending

Name _____

Signature _____

